

Remarks

Claims 1-15, 17 and 19-24 are pending in the application. Claims 1, 2, 4-8, 10, 12, 15 and 19-22 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,180,201 to Hauber. Claims 3 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hauber in view of U.S. Pat. No. 2,427,909 to Howell. Claims 9, 11, 13, 14, 23 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hauber in view of U.S. Pat. No. 2,473,065 to Miller. Claims 1, 12 and 20 are amended herein. The Applicant believes the amendments to the claims place the claims in condition for allowance over the prior art of record.

The Applicant thanks the Examiner for the courtesies extended in the interview conducted with Applicant's representative on May 11, 2006.

I. Claims 1, 2, 4-8, 10, 12, 15 and 19-22 Are Not Anticipated by Hauber

Claims 1, 2, 4-8, 10, 12, 15 and 19-22 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,180,201 to Hauber. Claims 1, 12, and 20 have been amended. Claims 1, 2, 4-8, 10, 12, 15 and 19-22 each recite a spindle and an inside and an outside locking mechanism (or an inside and an outside lock) on the respective inside and outside ends of the spindle. The specification describes such operability of the lock at page 8, line 21 to page 9, line 14.

Hauber does not disclose a lock as claimed. Hauber states that the latch can be "locked by the outside handle 18," (Col. 4, lines 29-30), and that the latch "can be opened by rotation of the inside handle 46, provided the nut 38 is pushed out of locked engagement with the bushing reduced end portion shoulder 34." Hauber does not describe a device, however, wherein the shaft (14) can be selectively locked against rotation by an inside lock or inside locking mechanism such that the shaft (14) cannot be rotated by manipulation of the outside end of the shaft (14) (such as by manipulation of the outside handle (18)). Nor does Hauber describe a device wherein the inside lock is operable to permit rotation of the shaft (14) when the shaft has

been locked by the outside handle (18). Indeed, in the device of Hauber, the shaft (14) can only be positively locked and unlocked from the outside.

Therefore, Hauber does not disclose every limitation recited in any one of claims 1, 2, 4-8, 10, 12, 15 and 19-22, and the rejection of these claims under 35 U.S.C. 102(b) should be withdrawn.

**II. The Office Action Has Not Made a Prima Facie
Case of Obviousness as to Claims 1-11 and 16-24**

The Examiner has the burden to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103(a). See MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. See MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See *Id.* Indeed, the proposed modification cannot render the prior art unsatisfactory for its intended purpose and cannot change the principle of operation of a reference. See MPEP 2143.01. Second, there must be a reasonable expectation of success. See MPEP 2143. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See *Id.* (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

A. Claims 3 and 17 are Patentable Over Hauber in View of Howell

Claims 3, 16 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hauber in view of Howell. Claim 16 is cancelled. The Office action states, "Howell teaches a key cylinder 22 on an outside handle 20," and it "would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a lock cylinder with the key lock on the outer handle of Hauber, in view of the teaching of Howell..." (p. 3) The Applicant respectfully traverses this rejection.

Like the claims discussed above, claims 3 and 17 both require a spindle and an inside and an outside locking mechanism (or an inside and an outside lock) on the respective inside and outside ends of the spindle. Both of these claims also require that the inside and outside locking mechanisms (or inside and outside locks) be operable to selectively permit and selectively prevent rotation of the spindle by manipulation of the outside end of the spindle. As discussed above, Hauber does not describe a lock wherein the inside and outside locks are operable to selectively permit and selectively prevent rotation of the spindle by manipulation of the outside end of the spindle (such as by manipulation of the outside handle (18), for example). Indeed, in the device of Hauber, the shaft (14) can only be both positively locked and unlocked by using the outside handle (18). Howell similarly describes a lock wherein the shaft (26) can only be positively locked and unlocked by an outside locking mechanism (22). As explained in Applicant's specification, such systems "cannot be locked or unlocked from the inside of a garage door...." (page 3, lines 9-11)

Therefore, the references do not teach or suggest all of the claim limitations. Accordingly, the Office Action does not establish a *prima facie* case of obviousness, and the rejection of claims 3 and 17 under 35 U.S.C. 103(a) should be withdrawn.

B. Claims 9, 11, 13, 14, 23 and 24 are Patentable over Hauber in View of Miller

Claims 9, 11, 13, 14, 23 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hauber in view of Miller. The Office action states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an inner escutcheon for the inner handle and yoke of Hauber (201) in view of Miller (065)." The Applicant respectfully traverses this rejection.

Claims 9, 11, 13, 14, 23 and 24 each recite a garage door locking system that includes inside and outside locking mechanisms (or inside and outside locks) that each are operable to selectively permit and selectively prevent rotation of the spindle by manipulation of the outside

end of the spindle. As discussed immediately above, Hauber does not describe such a garage door locking system. Miller also fails to disclose such a locking system. Therefore, the cited references do not disclose all of the claim limitations, and at least for this reason, the rejection should be withdrawn.

In addition, Miller does not disclose or suggest an inside escutcheon as required by each of the rejected claims. A person of ordinary skill in the art at the time of the invention would understand that an "escutcheon" is a protective or ornamental plate or flange. As described in the specification, the inside escutcheon covers the functional inside portions of the lock, and helps to provide a "finished and elegant appearance to the interior of a door." (page 8, lines 6-9) Miller simply does not disclose or suggest an inner escutcheon as recited in the subject claims. The Office Action states that Miller teaches an inside escutcheon 11, 17. The base (11) and central portion (17) do not protect or cover any exposed operable inside portions of the lock described in Miller. To the contrary, the base (11) and central portion (17) of Miller underlie and are substantially hidden by the operable inside portions of the lock. Accordingly, the cited references do not teach or suggest all of the claim limitations, and the rejection should be withdrawn.

Therefore, the Office Action does not establish a *prima facie* case of obviousness, and the rejection of claims 9, 11, 13, 14, 23 and 24 under 35 U.S.C. 103(a) should be withdrawn.

Conclusion

Applicant believes this case is now in condition for the immediate allowance of Claims 1-15, 17 and 19-24, and such action is respectfully requested. Accordingly, the Applicant requests entry of this amendment and allowance of the pending claims. If any issue remains unresolved, however, Applicant's attorney welcomes the opportunity for a telephone interview to expedite allowance and issue.

Respectfully submitted,


Jeffrey R. McFadden
Registration No. 46,916

Womble, Carlyle, Sandridge, & Rice PLLC
P.O. Box 7037
Atlanta, GA 30357-0037
(336) 721-3730

Craig H. Popalis
Registration No. 49,028

Womble, Carlyle, Sandridge, & Rice PLLC
P.O. Box 7037
Atlanta, GA 30357-0037
(336) 574-8099

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